



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/579,750	05/18/2006	Enrico Berti	P08930US00/MP	3028

881 7590 09/16/2010
STITES & HARBISON PLLC
1199 NORTH FAIRFAX STREET
SUITE 900
ALEXANDRIA, VA 22314

EXAMINER

HOOK, JAMES F

ART UNIT	PAPER NUMBER
----------	--------------

3754

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

09/16/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

iplaw@stites.com

Office Action Summary	Application No. 10/579,750	Applicant(s) BERTI ET AL.	
	Examiner James F. Hook	Art Unit 3754	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/24/10.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 4-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification as originally filed does not seem to support the language of the claims as amended which seem to set forth either applying lubricant to both layers, although it is unclear from the manner in which the claims have been amended whether such is the case, however, should applicant be trying to claim a coating provided on two different surfaces separately then there appears to be no support in the specification for this and therefore such would be new matter. However, should this not be what applicant was intending then the language of the claims should either be corrected or explained in any subsequent action.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. As set forth above, the amended claim language is

Art Unit: 3754

unclear as to whether or not a coating applied to two different surfaces is required or whether only contact between the lubricating layer and two surfaces is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 4-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Fujimoto. The reference to Fujimoto discloses the recited pipe for conveying hot fluids comprising an inner carrier tube 12 made of metal such as steel, at least one layer of heat insulating material 18 of polystyrene foam, an outer casing tube 13 made of metal such as steel, and a film of non adhesive and lubricating material 17 is provided where such can be formed of thermoplastic polyolefins such as polypropylene as well as an additional lubricant layer between this layer and the outer casing tube which can be formed of various materials including oils, where such controls friction between the heat insulating material and the inside surface of the outer casing tube inherently, and all the layers are fixed together by the resin and the insulation with the surface of the carrier tube and outer casing tube.

Claims 4-6, 8, and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Blin. The reference to Blin discloses the recited pipe for conveying hot fluids comprising an inner carrier tube C inherently made of material where such is believed to be a metal

Art Unit: 3754

or plastic material, at least one layer of heat insulating material 19 of silicone foam, an outer casing tube 21 made of elastomeric material, and a film of non adhesive and lubricating material is provided on surface 25, where such controls friction between the heat insulating material and the outside surface of the inner carrier tube inherently, and all the layers are fixed together by the resin or heat activated film between the insulation and the surface of the carrier tube.

Response to Arguments

Applicant's arguments filed June 24, 2010 have been fully considered but they are not persuasive. With respect to Fujimoto, column 3, lines 21-35 sets forth foam and/or lubricating layers being provided between the outer pipe inner wall and the outer wall of the intercalary material which can be considered the inner pipe as well, therefore the use of a foam layer which inherently would be insulating to some extent, and a lubricating layer is taught, where if one considered the intercalary material pipe to be the inner pipe such is a composite material such as concrete. It is immaterial whether Fujimoto actually shows in a figure or an example that the foam and lubricating layer are both used together, it is only required to set forth that this combination was known, and the recitation in Fujimoto in column 3 states that foam and a lubricating layer can be used. With respect to Blin, there is no discussion of why the lubricating layer of Blin is not teaching a film when such is disposed on the insides of the ribs and that would meet the claim language where there is no requirement for complete coverage. Pipe C is the inner tube and lubricant is provided between the inner pipe and the insulation where the

Art Unit: 3754

claim language does not require direct contact or exclude other layers being provided between the lubrication layer and the insulation, therefore Blin is still considered to read upon the claim language when the claims are open ended and allow for additional structure in the reference.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references to Neumann and Kojima disclosing state of the art insulation systems.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 3754

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James F. Hook whose telephone number is (571) 272-4903. The examiner can normally be reached on Monday to Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on (571) 272-4720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James F. Hook/
Primary Examiner, Art Unit 3754

JFH